

REMARKS

Applicants thank Examiner Gross for discussing the present application in the telephonic interview on January 29, 2009 with the undersigned.

During the interview, the undersigned explained that Applicants intended to file a Response along with a Declaration Under Rule 132 to establish inventorship for the claimed invention. Examiner Gross stated that the declaration would require further consideration and/or search. Accordingly, this Response is filed along with a Request for Continued Examination.

This application is amended in a manner believed to place it in condition for allowance at the time of the next Official Action.

Status of the Claims

Claims 1, 2, 4, 7-15, and 19 remain pending in the application.

Claim Rejections-35 USC §102

Claims 1, 2, 4, 7-15, and 19 were rejected under 35 U.S.C. §102(f) because applicants did not invent the claimed subject matter. This rejection is respectfully traversed for the reasons that follow.

The position of the Official Action was that the Enveloppe Soleau, for which a verified English translation was

filed with the amendment of January 9, 2008, indicated two co-authors, i.e., Pascal JANVIER and Isa BENITEZ, who are not listed as named inventors of the claimed invention.

However, the Examiner's attention is respectfully directed to the Declaration Under Rule 132 included in the appendix of the present response.

One of the named inventors of the present application, i.e., Bruno BUJOLI, declares to the extent that the subject matter of any of claims 1, 2, 4, 7-15 and 19 is disclosed by the Enveloppe Soleau, this subject matter was conceived by the present inventors, and not the other co-authors of the Enveloppe Soleau, Pascal JANVIER and Isa BENITEZ. Also, to the extent that the Enveloppe Soleau discloses the subject matter of any of claims 1, 2, 4, 7-15 and 19, Bruno BUJOLI declares that this disclosure was conceived the present inventors, and not the other co-authors identified in the Enveloppe Soleau, Pascal JANVIER and Isa BENITEZ.

Therefore, the named inventors of the present application did invent the subject matter as claimed, and withdrawal of the rejection is respectfully requested.

Claim Rejections-35 USC §103

Claims 1, 2, 4, 7-15, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over AGRAWAL et al. WO 2003/046508 A2 ("AGRAWAL") in view of PETRUSKA et al.

1998("PETRUSKA") and LOCKHART et al. US 5,556,752, and further in view of GAGNA et al. US 6,936,461. This rejection is respectfully traversed for the reasons below.

The present application claims priority to French application No. 02/09456 filed July 25, 2002. As declared by one of the present inventors, i.e., Bruno BUJOLI, in a Declaration Under Rule 131, an Enveloppe Soleau, dated April 30, 2001, was filed by Applicants with the French Patent Office (INPI) on May 17, 2001 to register a date for the claimed invention. Bruno BUJOLI further declared in the Declaration Under Rule 132 in the appendix of the present response that the presently named inventors invented the claimed subject matter, i.e., as discussed above relative to the 102(f) rejection.

Accordingly, the subject matter of any of claims 1, 2, 4, 7-15 and 19 has an effective date prior to the 102(e) dates of both AGRAWAL, i.e., November 9, 2001, and GAGNA, i.e., July 31, 2001.

Thus, neither AGRAWAL nor GAGNA qualify as prior art with respect to the claimed invention.

The remaining applied publications PETRUSKA and LOCKHART fail to render obvious the claimed invention.

PETRUSKA relates to a film of Langmuir-Blodgett type comprising metal (zirconium) phosphonates. PETRUSKA describes a solid support the surface of which is covered with zirconium by means of phosphonic acid (spacer) (see scheme 1, page 132).

However, PETRUSKA fails to describe the bonding of a biopolymer with said solid support.

LOCKHART describes solid supports $Y - L^1 - X^1 - L^2 - X^2$ (see column 8, line 30), wherein Y represents said solid support, L^1 represents an optional spacer, L^2 is a linking group having sufficient length such that X^1 and X^2 form a double-stranded oligonucleotide, and X^1 and X^2 represent a pair of complementary oligonucleotides.

However, LOCKHART fails to disclose or suggest solid supports having a surface of which is covered with a metal. Furthermore, the biopolymer of LOCKHART (X^1 and X^2 oligonucleotides) is linked to the solid support by means of a hydroxyl group (column 9, lines 43-45). Thus, LOCKHART fails to disclose an ionocovalent bonding between the metal surface of a solid support and the phosphate group of a biopolymer.

Thus, it would have been unobvious for one of ordinary skill in the art to even approach claimed biochip in view of PETRUSKA and LOCKHART, as there was no recognition of ionocovalent bonding between a metal surface and a phosphate group of a biopolymer.

Therefore, the proposed combination does not render obvious any of claims 1, 2, 4, 7-15 and 19, and withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing remarks and accompanying declaration, this application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our credit card which is being paid online simultaneously herewith for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

- Declaration Under Rule 132 by Bruno BUJOLI.